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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,688	09/12/2003	Carlos Alberto Godoy	741014.1021	9781
21831	7590	08/05/2005	EXAMINER	
STEINBERG & RASKIN, P.C. 1140 AVENUE OF THE AMERICAS, 15th FLOOR NEW YORK, NY 10036-5803				WRIGHT, ANDREW D
ART UNIT		PAPER NUMBER		
3617				

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/662,688	GODOY, CARLOS ALBERTO	
	Examiner	Art Unit	
	Andrew Wright	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 10 and 11 is/are allowed.
- 6) Claim(s) 1-4,8 and 9 is/are rejected.
- 7) Claim(s) 5-7 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)                    4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/3/04.                    5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Garofalo (US 5,443,593). Garofalo shows a swim fin with a shoe (2) and a blade (1). Shoe is made of a first soft material, and blade is made of more rigid material (column 1, lines 60-65). Blade has lateral ribs (5). Blade has longitudinal slots (102, 102') and openings (101, 101'). The slots are symmetric about the long axis of the fin. The openings extend diagonally from the shoe toward the lateral edges of the blade at least along a portion of the opening. The slots and openings are filled with a second soft material, which is the same material as the shoe (column 2, lines 3-5). It is noted that in applicant's disclosure the first and second relatively yielding materials are the same material.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3617

4. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo (US 5,443,593) in view of Semeia (US 6,568,974). Regarding claim 2, Garofalo does not show that the ribs (5) are lined with the soft material. Semeia shows a swim fin with a composite structure like that of Garofalo. Semeia shows a frame (4) of rigid material, and the remainder of the swim fin, including the shoe, slots and openings in the frame, and a lining around lateral edges of the frame, being of a softer material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by lining the ribs (5) with the softer material as taught by Semeia. The motivation would be to optimize the feel and hydrodynamic efficiency of the swim fin.

5. Regarding claim 8, Garofalo shows a curb (401) at the front free edge of the blade. The curb is made of soft material and connects the soft material in the slots and openings. Semeia shows that the lining of the ribs extends all the way to the front edge of the ribs. Therefore the lining would intersect the curb.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo in view of Semeia as applied to claim 2 above, and further in view of Mehrmann et al. (US 6,224,443). Semeia teaches that two or more different materials can be used for making the various parts of the frame, which includes the lateral ribs. Mehrmann shows a flipper made of different hardness materials. The shoe can be made of soft 30 durometer material, the blade of rigid 90 durometer material, and the lateral ribs of intermediate 80 durometer material. Therefore it would have been

obvious to one having ordinary skill in the art at the time the invention was made to further modify Garofalo by making the ribs from a material with intermediate hardness.

The motivation would be to optimize the hydrodynamic performance of the swim fin.

7. Regarding claim 4, both Garofalo and Semeia show that the ribs enlarge in the rearward direction. Therefore the lining on the rib would also enlarge along with the rib. The structure can be considered a fairing.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garofalo (US 5,443,593) in view of Semeia (US 6,568,974) and Takizawa (US 5,304,081).

Garofalo shows a swim fin with a shoe (2) and a blade (1). Shoe is made of soft material, and blade is made of more rigid material (column 1, lines 60-65). Blade has lateral ribs (5). Semeia shows a swim fin with a composite structure like that of Garofalo. Semeia shows a frame (4) of rigid material, and the remainder of the swim fin, including the shoe and a lining around lateral edges (i.e. ribs) of the frame, being of a softer material. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by lining the ribs (5) with the softer material as taught by Semeia. The motivation would be to optimize the feel and hydrodynamic performance of the swim fin. Both Garofalo and Semeia show that the ribs enlarge in the rearward direction. Therefore the lining on the rib would also enlarge along with the rib. This enlargement is at a flank portion of the shoe. This enlargement creates a sideways projecting fairing.

9. Still regarding claim 9, Garofalo does not show the rearward extent of the blade, and does not show the connections for a strap. Garofalo does show that the lateral rib portion of the blade flanks the foot pocket. And that portions of the blade form flanks at the sides of the front part of the shoe. One wishing to make and/or use the Garofalo fin would necessarily have to determine how to construct the rearward extent of the fin that is not shown by Garofalo, and would look to the prior art for guidance. Takizawa shows a swim fin with a shoe and blade. The blade has lateral ribs. The ribs extend rearward to form flanking portions of the shoe. The portions terminate in a hood with a seating for buckle (5) to engage. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Garofalo by extending the ribs rearward and providing a seating for a buckle for a strap. The motivation would be to provide a known apparatus for connecting a heel strap for the purpose of keeping a user's foot inside the pocket. It is noted that the term "sideways" is not given any relative meaning the claim. The lateral rib (6) of Takizawa extends sideways in a direction from the bottom of the shoe toward the top of the shoe. In this direction the rib has a thickness not less than that of the buckle (5).

***Allowable Subject Matter***

10. Claims 10 and 11 are allowed.
11. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments filed 5/31/05 regarding the drawing objection is persuasive. The drawing objection is withdrawn.
13. Applicant's arguments filed 5/31/05 regarding claims 1-4, 8, and 9 have been fully considered but they are not persuasive. Regarding claim 1, applicant argues that Garofalo does not show "a pair of diagonal slits that extend in a substantially transverse direction, from the longitudinal side of the fin to the shoe edge" (Remarks, page 15). It is noted that this is not recited in the claims. Claim 1 does not recite "substantially transverse direction", but rather recites "extending diagonally". Claim 1 does not recite "from the longitudinal side of the fin to the shoe edge", but rather recites "from the shoe toward lateral edges of the blade" (emphasis added). Claim 1 does not recite "two diagonal openings extending from the side ... edge of the blade to the shoe", but rather recites "from the shoe toward lateral edges of the blade" (emphasis added). Since applicant is arguing elements that are not recited in the claims, the arguments are not persuasive. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
14. Regarding claim 2, applicant argues that neither Semeia nor Garofalo discloses the considerable improvement in the "spoon effect" of the fin (Remarks, page 20). The spoon effect is not recited in the claims. Applicant is arguing features that are not

recited in the claims. As such the argument is not persuasive. Semeia teaches the use of material around the ribs. The rejection is proper.

15. Regarding claim 8, applicant argues that neither Semeia nor Garofalo discloses a fin with “an enlarged front edge” (Remarks, page 20). An enlarged front edge is not recited in the claims. Applicant is arguing features that are not recited in the claims. As such the argument is not persuasive. Garofalo shows a curb at the front edge. The rejection is proper.

16. Regarding claim 3, applicant does not make any arguments against the rejection set forth in the Office Action. Thus the rejection is maintained.

17. Regarding claim 4, applicant merely alleges that neither Garofalo nor Semeia disclose the lining enlarging rearwardly to form a fairing (Remarks, page 20). Applicant does not address the rejection set forth in the Office Action where it is asserted that the modified invention would necessarily have an enlarged lining that constitutes a fairing. Thus the argument is not persuasive.

18. Regarding claim 9, applicant alleges that neither Garofalo nor Semeia disclose the lining enlarging rearwardly to form a fairing (Remarks, page 20). Applicant does not address the rejection set forth in the Office Action where it is asserted that the modified invention would necessarily have an enlarged lining that constitutes a fairing. Thus the argument is not persuasive.

19. Further regarding claim 9, applicant argues that the Takizawa fin is contrary to applicants fin (Remarks, page 20). Takizawa shows elements of claim 9 as described in the rejection. The raised sides that applicant refers to constitute two arms that extend

backwardly to form containment flanks for the shoe. It is noted that "defining a cavity therebetween" is not recited in the claim. It is also noted that "the side profile of the fin" is not recited in the claim. Applicant is arguing features that are not recited in the claims. As such the argument is not persuasive.

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication should be directed to examiner Andrew D. Wright at telephone number 571-272-6690. The examiner can normally be reached Monday-Friday from 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano, can be reached at 571-272-6684. **The Central FAX Number for official communications is 571-273-8300.** The fax number directly to the examiner for unofficial communications is 571-273-6690.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew D. Wright  
Patent Examiner  
Art Unit 3617

ANDREW D. WRIGHT  
PRIMARY EXAMINER

Aug 2/05